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10/708,562	03/11/2004	Rakesh K. Parimi	FIS920030422	2561

23550 7590 05/21/2007	EXAMINER
HOFFMAN WARNICK & D'ALESSANDRO, LLC	MASKULINSKI, MICHAEL C
75 STATE STREET	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 March 2007</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Final Office Action

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-13 are not limited to tangible embodiments. In view of Applicant's disclosure, specification paragraph 0026, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., data storage system) and intangible embodiments (e.g., transmission media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

3.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4.   Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Farchi et al., US 2003/0046613 A1.

Referring to claims 1, 9, and 14:

a.   In paragraph 0012, Farchi et al. disclose testing a client program for opening a connection to a server (performing automatic testing of a system including a plurality of modules in which at least two modules lack a predetermined communication mechanism).

b.   In paragraph 0016, Farchi et al. disclose creating a test suite for testing a

program (establishing at least one test goal for testing regarding at least one of a

module and an interface point between modules; providing at least one test script

configured to conduct a test at each module and each interface point).

c.   In paragraph 0016, Farchi et al. disclose that the output from the test

coverage tool is generated in the same language that was used to write the

coverage criteria that are input to an automated test generator to create the test

cases, which form the test suite. As a result, the output from the coverage tool

can be input into the automated test generator to cause the generator to

automatically revise the test cases to correct inadequacies (generating a test

map for each test goal, each test map configured to run at least one test script for

each module and each interface point in accordance with the test goal; and

automatically testing the system using each test map).

d.   With respect to claim 9, in paragraph 0023, Farchi et al. disclose a

computer readable medium embodying computer-readable code.

Referring to claims 2, 10, and 15, in paragraph 0026, Farchi et al. disclose that

the coverage tool generates a test coverage report based on the test trace and the

coverage criteria and this report is utilized to judge the suitability of the program under

test (the step of scoring a test result for at least one of the test goal and each test

script).

Referring to claims 3, 11, and 16, in paragraph 0030, Farchi et al. disclose that

by inputting test traces from multiple test suites, test suites that are too restrictive and/or

that are inefficient can be identified and additional criteria can be automatically created to correct those deficiencies (wherein a test script is included in a test map only if the test script has a score that is greater than a threshold score).

Referring to claims 4, 12, and 17, in paragraph 0030, Farchi et al. disclose that by inputting test traces from multiple test suites, test suites that are too restrictive and/or that are inefficient can be identified and additional criteria can be automatically created to correct those deficiencies (wherein the generating step includes generating a test map for a given test goal only if the given test goal has a score that is greater than a threshold score).

Referring to claims 5 and 18, in paragraph 0026, Farchi et al. disclose that the coverage tool generates a test coverage report based on the test trace and the coverage criteria (further comprising the step of recording a test result for each test script).

Referring to claim 6, in paragraph 0016, Farchi et al. disclose creating a test suite (further comprising the step of recording each test map).

Referring to claims 7 and 19, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases, which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (further comprising the step of repeating the steps of generating and automatically testing after correction of a failure).

Referring to claims 8, 13, and 20, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (further comprising the step of modifying the test map based on a modeling rule).

Response to Arguments

5.   Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

6.   On page 6, under the section **III. REMARKS**, the Applicant argues against the rejection of claims under 35 U.S.C. 101. The Applicant relies upon case law concerning a carrier signal modulated with computer code. However, this is not relevant because the Applicant's specification only discloses "transmission media". The Examiner requests that the Applicant point to where in the specification it is stated that the transmission media is a carrier signal modulated with computer program code. Further, the Examiner is unsure as to how the Applicant's amendments overcome the rejections. Having a computer execute the instructions does not mean that they are stored on a tangible medium. The Examiner suggests amending the claims to recite a tangible medium or canceling the claims. The Examiner directs the Applicant to the Interim Guidelines found at

http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm and the MPEP

for further guidance.

7.   On page 7, under the section **III. REMARKS**, the Applicant argues, "Farchi only

discloses creating a test suite comprising test cases, i.e., 'individual programs which

carry out the tasks to be accomplished as identified by the coverage criteria.' (¶ 0003).

Farchi does not include providing at least one test script to conduct a test <u>at each</u>

module and <u>each</u> interface point (emphasis by Applicant). Farchi is related to

measuring test coverage but never goes to the details of the software system to be

tested. As such, Farchi does not disclose that the system to be tested includes a

module and/or an interface point." The Examiner respectfully disagrees. In paragraph

0016, Farchi et al. disclose creating a test suite for testing a program. In paragraph

0025, Farchi et al. disclose running the test suite. In paragraph 0012, Farchi et al.

disclose providing a test script at each module and interface, e.g. testing a client

program for opening a connection to a server.

8.   On page 7, under the section **III. REMARKS**, the Applicant argues, "Moreover, in

the claimed invention, a test script, by definition, resides <u>at</u> the respective module or

interface point (see current application at ¶ 0033). The test suite, or test cases, of

Farchi does not reside at the software system to be tested. In response to applicant's

argument that the references fail to show certain features of applicant's invention, it is

noted that the features upon which applicant relies (i.e., the test script residing at the

respective module or interface point) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Applicant fails to show where the test suite or test cases reside in Farchi et al. For this reason, the Applicant has failed to show a distinction between what the Applicant regards to be his/her invention and the reference of Farchi et al.

9.   On page 7, under the section **III. REMARKS**, the Applicant argues, "The test suite in Farchi includes test cases to achieve test tasks. However, Farchi does not disclose a sequence of the running of the test cases. In contrast, 'a 'test map' (in the claimed invention) is a sequence of stored test cases to be run in sequence for each module and interface point in accordance with a test goal.' (Current application at ¶ 0033 [sic], parenthetical explanation added). As such, Farchi does not include a test map as in the claimed invention." The Examiner respectfully disagrees. In paragraph 0025, Farchi et al. disclose running a test suite and as stated by Applicant a test suite in Farchi et al. includes test cases. Therefore, when the test suite is run, a sequence of test cases is run. This is a test map.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Maskulinski whose telephone number is 571-272-3649. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C Maskulinski
Examiner
Art Unit 2113